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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/993,893 12/18/97 HIROSE

M 5729.0015

FINNEGAN HENDERSON FARABOW GARRETT  
& DUNNER  
1300 I STREET NW  
WASHINGTON DC 20005

QM11/1221

EXAMINER

HIROSE, R

ART UNIT

PAPER NUMBER

3723

DATE MAILED:

12/21/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/993,893</b>	Applicant(s) <b>Hirose et al</b>
	Examiner <b>Robert Rose</b>	Group Art Unit <b>3723</b>

Responsive to communication(s) filed on May 15, 1998.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-43 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-43 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been  received.

received in Application No. (Series Code/Serial Number) 08/124,550.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. Receipt is acknowledged of Applicant's Preliminary Amendment, filed May 15, 1998.
2. Receipt is acknowledged of Applicant's Prior Art Statement, filed May 15, 1998.
3. Receipt is acknowledged of Applicant's Foreign Priority Papers, filed in Applicant's parent application 08/124550.
4. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
5. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. Applicants must distinctly specify the excess or insufficiency in the claims. What limitation(s) in the claims of US patent 5,476,414 are considered by Applicants to be too narrow, or otherwise unnecessary for patentability?
6. The reissue oath/declaration filed with this application is defective because it fails to particularly specify the errors and how the errors relied upon arose or occurred as required under 37C.F.R. 1.175(a)(5). Applicants' are required to specify how and when these errors arose, as well as how and when these errors were discovered.
7. Claims 1-43 are presented for examination.

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8. Claims 1-43 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

9. Claims 17, 35-36, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 17, lines 9-12 it is unclear what element corresponds to the recited "plate...having an annular lower projection at a lower surface thereof, which contacts the upper surface of said top ring". Similarly, in claims 35 and 38, the recitation of the "pressure adjuster...including an annular portion which contacts an upper surface of the top ring"

10. Claims 1-21, 26-33, 34/30, and 37 are allowed.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 22-25, and 39-43 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Koeth et al. Koeth et al discloses a polishing apparatus comprising all of the subject matter set forth in the claims above. Note top ring(16)(18); top ring drive shaft(12); bearing(32)(34); and biasing means(14). The fingers of torque plate(14) are read as a plurality of biasing members.

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With regard to claim 41, the upper top ring member(16) has an annular portion adjacent the gasket(72) which contacts the upper surface of the lower top ring member(18).

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 34/22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koeth et al in view of Gill, Jr. et al. Gill, Jr. et al discloses a wafer transfer device for transferring a wafer from a polishing apparatus comprising a spring supported holder. To provide the polishing apparatus with a work transfer device in the form of a spring supported holder in the vicinity of the turntable in order to smoothly transfer wafers to and from the top ring without breakage would have been obvious in view of Gill, Jr. et al.

15. Claims 17, 35-36, and 38 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

16. Any inquiry concerning this communication should be directed to Robert Rose at telephone number (703) 308-1360.

Rr

December 21, 1998.



**ROBERT A. ROSE**  
**PRIMARY EXAMINER**  
**ART UNIT 322**